

REMARKS

A non-final Office Action, dated March 30, 2004, rejects pending claims 1-61. Reconsideration is respectfully requested in light of the concurrently submitted declaration of Stephen Garrett and the following remarks.

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-61 as somehow being rendered obvious by the references of record. Empirical evidence overwhelmingly supports a conclusion of non-obviousness. Moreover, the references of record are either missing essential elements or they are missing a teaching or suggestion to combine them as currently claimed. All of these grounds for traversing the examiner's 35 USC §103 rejections are discussed in greater detail below:

A, Evidence of Non-Obviousness

1. Evidence of Long-Felt Need That Was Recognized , Persistent, and Not Solved by Others.

The best example of the need for better prescription order tracking and will-call retrieval can be found by conducting a brief search of recent judgments against pharmacies for distributing the wrong prescription to customers. For example, a jury recently awarded a customer of Wal-Mart Stores, Inc. over \$800,000 in damages for accidentally giving that customer the filled prescription order of another customer who had the same last name. A copy of the court ruling affirming that judgment is attached to the concurrently filed Declaration of Stephen Garrett.

The issue of pharmacies distributing incorrect prescription orders to customers has been around for a long period of time. For example, a scene in the classic 1946 film "It's A Wonderful Life" focuses on the main character, George Bailey, correcting a mistake of the pharmacist that would have resulted in a customer receiving the wrong prescription order.

Yet, despite this long felt need to correct this problem and the prior attempts of others to correct it, many customers are still inadvertently being given the wrong prescription orders.

The present invention successfully corrects this problem by performing at least one, and preferably all, of the following steps:

- a. automatically tracking a filled prescription order throughout the pharmacy (claims 1, 9, and 57);
- b. automatically tracking a customer's filled prescription within a storage area (claim 24);
- c. providing a storage area with individual storage areas, with each one having a unique identifier (claim 31);
- d. tracking a filled prescription order to a specific, worker elected, individual storage area (claim 44), wherein the visual identifier for that storage area is not related to information contained within the customer information (claims 46-47);
- e. automatically verifying that a particular prescription order removed from a particular individual storage area is the correct prescription of the customer seeking to pick-up his or her prescription order (claim 52).

Since there has been a long-felt need for the present invention, and that need was recognized and persistent, but since others did not solve that need prior to the present invention, applicants maintain that the references of record cannot be interpreted so as to render the present invention obvious.

2. Commercial Success

Applicants respectfully traverse the examiner's 35 USC § 103 rejections of claims 1-61 on the grounds of applicant's commercial success derived from the claimed invention under MPEP § 716.03. Evidence in support of applicants' commercial success is provided in the attached declaration of Stephen Garrett dated September 30, 2004.

As Mr. Garrett's declaration states, assignee of record, GSL Solutions, Inc. was a start-up organization with little funding and no customers entering a field dominated by a handful of well-funded, large manufacturers. At the time GSL Solutions, Inc. introduced its automated tracking and will-call storage and retrieval system, no pharmacy equipment manufacturer offered the benefits of GSL Solutions, Inc.'s system.

Despite the short time since GSL Solutions, Inc. has been in business, its limited size and resources, and numerous obstacles resulting from having an industry dominated by a hand-full of well-financed and well-connected manufacturers, GSL

Solutions, Inc., and its one product -- the claimed invention, have had numerous sales and have grown to become a viable and competitive pharmacy equipment manufacturer.

In the present case, GSL Solutions, Inc.'s success cannot be attributed to its already existing status in the industry or to its superior sales forces or advertising. It has become successful in such a short time despite its initial weak position in the industry.

A particular high point in GSL Solutions, Inc.'s success to date is the fact that a commercial embodiment of the structure disclosed in U.S. Pat. No. 6,464,142 to Denenberg et al. has proven problematic for its customer, who has elected to replace it with GSL Solutions, Inc.'s system. (See Declaration of Stephen Garrett, paragraphs 2, 9 & 10.)

When pharmacies are facing multi-million dollar lawsuits over improperly dispensing filled prescription orders from an overstuffed and error prone will call storage system, and the dominate pharmacy equipment manufacturers are more interested in selling expensive, complex machinery, than solving this problem for its customers, GSL Solutions, Inc.'s commercial success underscore the value of its system and offers further evidence of the non-obviousness of the present invention.

3. Evidence of Copying

"Another form of secondary evidence which may be presented by applicants during prosecution of an application is evidence that the competitors in the marketplace are copying the invention instead of using the prior art. " MPEP § 716.06.

"Copying is an indicium of nonobviousness, and is to be given proper weight."

Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988).

As noted in the declaration of Stephen Garrett, at least one large, well-funded pharmacy equipment manufacturer was specifically shown the GSL Solutions, Inc. system in operation, and was specifically asked by a customer to copy it. Shortly thereafter, that customer purchased the large, well-funded, pharmacy equipment manufacturers' copied system. (See Declaration of Stephen Garrett, paragraphs 12-14.)

This copying further underscores the non-obviousness of the present invention.

In light of the fact that there had been a unresolved long felt need for GSL Solutions, Inc.'s system, GSL Solutions, Inc. is enjoying commercial success for its system, and its competitors have attempted to copy its system, applicants maintain that this evidence supports a finding that the present invention cannot be rendered obvious by any combination of the references.

B. There is no teaching or Suggestion to Combine the References of Record

Applicants also traverse the examiner's rejection of claims 1-61 on the ground that there is no teaching or suggestion to combine the noted references of record to produce the results as currently claimed. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so . . ." [MPEP § 2143.01]. In particular, there is no teaching or suggestion to combine Denenberg et al. (U.S. Pat. No. 6,464,142) with the cluster of linked freight items in Horwitz et al. (U.S. Pat. No. 6,496,806) to produce the invention as currently claimed in claims 1-43, or to combine Denenberg et al. with Isaacman et al. (U.S. Pat. No. 5,936,527) to produce the structures claimed in claims 44-61. Accordingly, these claims should also be allowable on these grounds.

C. There Are No References Of Record Showing Any Form OF Tag Reader Switching Device

Applicants continue to maintain that no references of record teach or suggest any structures for minimizing the expense associated with having a plurality of spaced apart tag readers within a pharmacy by periodically switching a common tag reader between a plurality of antennae located at spaced apart locations within the pharmacy. Claim 40 and 41 specifically included limitations directed to this structure. Since no references of record teach or suggest any form of tag reader switching structures as claimed in claims 40 and 41, these claims should also be allowable on these grounds.

D. Verifying Out At Time Of Customer Pick-Up

Applicants also maintain that no references of record teach or suggest the combination of elements set forth in claims 52-61. Namely, none of the references of record teach or suggest "the computer system comparing the identity of the patient whose filled prescription is being sought by the customer with the patient information

associated with the unique tag identifier to verify that the correct prescription order has been removed from the storage area" (Claim 51). Claim 57 includes a similar limitation. Accordingly, these claims and claims 52-56 and 58-61, which depend on these allowable claims should now be in condition for allowance.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

September 30, 2004

By



John R. Dawson
Registration No. 39,504

ipsolon llp
805 SW Broadway # 2740
Portland, Oregon 97205
Phone No. (503) 419-0702
Fax No. (503) 249-7068
E-Mail: john@ipsolon.com